Remarks

In the Office Action mailed April 19, 2006, the Examiner: (i) rejected claim 20 under 35 U.S.C. 101 as directed to non-statutory subject matter; (ii) rejected claims 1, 12, 13, 20 under 102(b) as being anticipated by U.S. Patent No. 5,631,984 to Graf ("Graf"); (iii) rejected claims 8, 9, 11, and 18 under 35 U.S.C. 103(a) as unpatentable over Graf in view of Reference U ("Gonzalez"); (iv) rejected previously canceled claims 3 and 16 under 35 U.S.C. 103(a) as unpatentable over Graf in view of U.S. Patent No. 5,982,502 to Jinnai ("Jinnai"); (v) rejected claims 4, 5, 6, 7, 15 and 17 under 35 U.S.C. 103(a) as unpatentable over Graf in view of Jinnai and Microsoft Corporation Word 9 ("Word 9"); (vi) rejected claim 17 as unpatentable over Graf in view of Word 9; (vii) rejected claim 19 under 35 U.S.C. 103(a) as unpatentable over Graf in view of Jinnai and Word 9.

In response, Applicant has amended claims 2, 14, and 20. Claims 1-2, 4-15, and 17-20 will be pending after entry of this Amendment.

I.   Claims 1, 12, 13, and 20

The Examiner rejected claims 1, 12, 13, and 20 under 35 U.S.C. 102(b) as anticipated by U.S. Patent 5,631,983 to Graf et al ("Graf"). Applicant respectfully traverses.

The MPEP clearly states that "[t]o anticipate a claim, the reference must teach each and every element of the claim." *MPEP 2131.* Applicant notes that claims 1, 12, 13, and 20 all require that the copier print the image only if it contains at least one handwritten notation[1] and that the Examiner has previously acknowledged that Graf does not teach this element. *Office Action mailed September 22, 2005 at pg 5.* For at least this reason, Applicant respectfully

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[1]   *See claims 1 and 12* ("printing the first image only if the first image contains at least one handwritten notation"); *claim 13* ("a processor configured . . . to print the first image only if the image contains at least one handwritten notation"); *and claim 20* ("printing the first image only if the first image contains at least one handwritten notation").

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submits that Examiner's rejections of claims 1, 12, 13, and 20 under Section 102(b) are improper.

II.   Claims 2 and 14

As previously noted, the September 2005 Office Action only rejected claims 2 and 14 under Section 112. The April 2006 Office Action does not include any additional rejections. Because the Examiner has not made any rejections under Section 102 or 103 in either Office Action, Applicant believes they should be considered allowable over the art of record. Accordingly, Applicant has amended these claims back to their 'as filed' dependancy, and then made a slight amendment to address the outstanding Section 112 issue.

The Examiner rejected claims 2 and 14 as failing to comply with the enablement requirement of Section 112. The Examiner clarifies in the April 2006 Office action that this rejection is based on two purported "errors":

> I.) Handwritten notations which are recognizable by the OCR system is [sic] classified as typewritten, and therefore incorrectly classified.
> II.) Figures and images, which are unrecognizable as text, will be classified as handwritten notations.

April 2006 Office action at pg. 2.

With respect to the first error, Applicant respectfully asserts that distinguishing between handwritten and typewritten characters is simply a matter of tuning and that the effort required to perform this tuning would be "undue"; the hard problem in the OCR field is classifying handwritten notations, not distinguishing a handwritten notations from a standard typefaces. However, to move prosecution forward, Applicant has attached an article from the incorporated references. This article discusses a standard-font system technique that, when coupled with the "over 200 font capacity" of 1985-era OCR machines, will work adequately for the vast majority of documents. Although Applicant believes that these techniques have become routine in the

intervening 25 years, Applicant will amend the Specification to explicitly include the incorporated material at Examiner's request.

With respect to the Examiner's second identified error, Applicant has amended the claims to clarify that the method only needs to detect a handwritten notation in the first image, not whether the image contains a handwritten notation. From an enablement standpoint, the fact that the claimed OCR technique may produce some false positives does not detract from the fact that it will also detect all handwritten notations. Although false positives may affect the success of the invention in the marketplace, they are not detrimental to general patentability.

III. Claims 4-7

Claims 4-7 are dependent on claim 2 and include of its limitations. Accordingly, because the Examiner has indicated that claim 2 is allowable over the art of record, Applicant respectfully asserts that claims 4-7 are also allowable over the art of record.

IV. Claims 8-11, 15, and 17-19

The Examiner rejected claims 8-11, 15, and 17-19 under Section 103 as being unpatentable over various combinations of Graf, Word 2000, Gonzales (reference U) and Jinnai. Under Section 103, the Examiner bears the burden of establishing a prima facie case of obviousness. *MPEP § 2142*. To satisfy this burden, three basic criteria must be met. First, there must be some suggestion or motivation to make the proposed modification or combination. Second, there must be a reasonable expectation of success. Third, the prior art reference (or references when combined) must teach or suggest all of the claimed limitations. *Id.* Accordingly, if none of the references teach or suggest a particular limitation, the Examiner's rejections will fail to meet the third criteria.

As previously noted, the Examiner has acknowledged that Graf fails to teach or suggest "printing the first image only if the first image contains at least one handwritten notation."

Microsoft Word 2000 also fails to teach or suggest this element. Instead, references U and V simply teach that Microsoft Word 2000 had a feature where you could track changes in an electronic document. There is no teaching of tracking changes to physical documents, much less "printing the first image only if the first image contains at least one handwritten notation."

Gonzales (reference W) also fails to teach or suggest this element. Instead, Gonzales (as best understood, the supplied copy is missing a portion of each line) simply teaches that you can detect motion by comparing frames. However, there is teaching or suggestion of searching for handwritten notations, much less "printing the first image only if the first image contains at least one handwritten notation."

Jinnai also fails to teach or suggest this element. Instead, Jinnai is directed at a facsimile machine that can store images of the documents. This facsimile machine can also read instructions from special "mark sheets." However, there is no teaching or suggestion of searching for handwritten notations, much less "printing the first image only if the first image contains at least one handwritten notation."

Accordingly, Applicant respectfully submits that no combination of Graf, Word 2000, Gonzales (reference U) and Jinnai can obviate claims 8-11, 15, and 17-19.
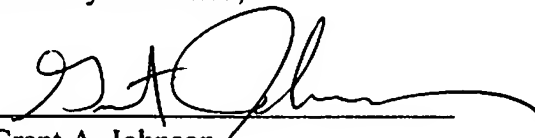
V.   Claim 20

The Examiner rejected claim 20 as directed to non-statutory subject matter, specifically signal bearing media. Although this rejection was not made in the September 2005 Office Action, Applicant has amend claim 20 to recite "tangible computer readable media."

VI. Conclusion

It is believed that the present application is in condition for allowance and a prompt and favorable allowance of all claims is respectfully requested. If the Examiner, upon considering this amendment, thinks that a telephone interview would be helpful in expediting allowance of the present application, he/she is respectfully urged to call the Applicant's attorney at the number listed below.

Respectfully submitted,

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